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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,426	06/28/2000	RICHARD HILICKI	HEH-2	6100

1473 7590 04/18/2002  
FISH & NEAVE  
1251 AVENUE OF THE AMERICAS  
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NEW YORK, NY 10020-1105

EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 04/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

APR 25 2002

FISH & NEAVE - PATENT DEPT  
REFERRED TO JDM  
NOTED BY JDM

FINAL

DOCKETED FOR July 18, 2002

# Office Action Summary

Application No.

09/606,426

Applicant(s)

Hilicki et al

Examiner

Mark Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 4, 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 10-33, 35, 37, 40-58, 60, 61, 63, and 65-68 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10-33, 35, 37, 40-58, 60, 61, 63, and 65-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-6, 8, 10-33, 35, 37, 40-58, 60, 61, 63 and 65-68 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over "ISBN 0-439-20822".

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The ISBN' discloses in Fig. 1-5, a book comprising a first book cover (A) and a second book cover (B) wherein the second book cover defines coin receivable apertures (C) in the interior side of one of the covers (Fig. 1) for receiving caps (coin) in which the diameter of the aperture is substantially equal to that of the coin, and wherein the book theme relates to a geographic region and is displayed on one of the covers (D in Fig. 2) and in the apertures (Fig. 1), a plurality of sheets fastened together (Fig. 3-5), wherein at least one sheet is blank (Fig. 5), at least one sheet provides preprinted information related to book theme (Fig. 3 and 4). The method of generating a book is also inherently taught by ISBN'.

However, ISBN' does not disclose a book: with a theme relating to a province, or a group of countries, or a fictional/non-fictional story; a plurality of sheets attached to the cover; wherein at least apertures are located on the exterior side of one of the covers; wherein one of the covers is made from card stock; and a cap with an image related to an image of a coin, a flag, flower, capitol and bird.

In regards to **Claims 1 and 44**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to attach the sheets to the covers, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the apertures at any desirable location on the cover, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re*

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*Japikse*, 86 USPQ 70. By placing the apertures on the exterior side of the cover, *the cover is only further being used as a display device by enhancing its marketability*. The “operation of the device (display book) would not be modified”, since shifting of the aperture from the interior to the exterior only enhances the display.

In regards to **Claims 3-6, 11-17, 22-32, 35, 40-42, 47-57 and 65-67**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desired indicia on the cover, sheet or caps, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

In regards to **Claims 8-17, 23, 25, 28, 30, 32, 45, 46 and 48-53**, it is also notoriously well known in the art to have a cap in the shape of a coin with various indicia.

In regards to **Claims 11 and 46**, it would have been an obvious matter of design choice to construct the cap with a diameter at any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

In regards to **Claim 68**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the covers with any desired material, since it has been

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held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

2. Claim 39 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over ISBN' in view of Phelps (3,217,866).

ISBN' discloses all the elements of a book as claimed in Claim 1 and as set forth above. However, ISBN' does not disclose a book having at least one sheet defining at least one aperture aligned with one of the covers.

Phelps discloses in Fig. 1, a book having a sheet (A) with apertures (B).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the ISBN' book to include a page having an aperture as taught by Phelps for the purpose of displaying a coin with pertinent data imprinted under each aperture as to the cap contained.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the aperture at any desirable location of alignment, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

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***Response to Arguments***

3. Applicant's arguments filed on March 4, 2002 have been fully considered but they are not persuasive.

In response to applicant's argument's that the prior art does not disclose placing the coin receivable apertures in the exterior of at least one of the covers, the examiner submits that it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the apertures at any desirable location on the cover, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. By placing the apertures on the exterior side of the cover, the cover is only further being used as a display device by enhancing its marketability. The "operation of the device (display book) would not be modified", since shifting of the aperture from the interior to the exterior only enhances the display.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

April 17, 2002

A. L. WELLINGTON  
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